

Taking a closer look at McGraw we see that it has nothing to do with the claimed invention. McGraw sets out to make lubricants for air *conditioner* compressors that:

are miscible in hydrofluorocarbon and hydrochlorofluorocarbon refrigerants in the range from - 20°C. to greater than 65 °C. and at the same time have a neat viscosity greater than 75 centistokes at 38° C. (100° F.). (see Col 2., lines 3-8)

The point of this was to avoid phase separation of the lubricant from the *refrigerant*. The modification of McGraw for selection of components in the disclosed compositions to avoid the formation of stable emulsions of the lubricant in condensed moisture is not suggested.

The Examiner has acknowledged that "...McGraw does not teach the recognition of the ability of the glycol/ester blends [of the pending application] to be resistant to the formation of stable emulsions with water..." Paper No 9, page 3. We agree, and further note that no suggestion exists in McGraw to modify it to produce the claimed lubricants. Nowhere in McGraw is the specific mention of the lubricants found, let alone their inability to form stable emulsions in water. Therefore, this reference provides no motivation to one skilled in the art to simultaneously select a component (1) wherein n is 0, R2 is methyl and X is derived from methanol, ethanol, propanol, or butanol; and a component (2) from a polyol ester or an aliphatic diacid ester.

Neither is there a suggestion to modify Ward to obtain the present invention. Ward discloses synthetic lubricating compositions comprising a combination of alkane/aromatic diester (derived from a monohydric alcohol and alkane/aromatic dicarboxylic acid) and a polyether polyol. The polyols used therein describe both end capped and non end capped polyols. As shown in Table 1, examples 1-4 and 8-10 pass the ASTM demulsibility test for polyalkylene glycol/diester blends, where the polyalkylene glycol is end capped according to the present invention. This test fails when conducted with a non end capped polyalkylene glycol/diester blend. Since Ward provides no guidance in selecting the end capped polyalkylene glycols/diester blends of the present invention, let alone which ones successfully avoid forming emulsions in water, it therefore does not render the present invention obvious.

Finally, the Applicants note that there is no suggestion to combine Smalheer with either McGraw or Ward. Neither Ward nor McGraw disclose the use of an antifoaming additive. Smalheer only discloses two types of antifoaming additives, silicone and organic copolymers, which are suitable to be added to lubricants in general. There is no teaching in

Smalheer of using these additives with the end capped polyakylene polyol/diester blends of Ward or McGraw, let alone the use of the silicone-free antifoaming additives of claim 11.

The Applicants respectfully submit that the Examiner has failed to provide a sufficient reason why either Ward or McGraw could be combined with Smalheer to obtain the present invention.

For these reasons, it is respectfully submitted that the claims are patentable over the prior art. The Examiner is kindly requested to reconsider and withdraw the rejection of the claims. If any point remains in issue which the Examiner feels may be best resolved through a personal or telephone interview, please contact the undersigned at the telephone number listed below.

All objections and rejections having been addressed, it is respectfully submitted that the present application is now in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

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